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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Salmonson, Roger
Serial No.: 10/608,744
Filed: June 27, 2003
For: TOPICAL ANALGESICS AND METHODS OF USE
Examiner: Michele Flood
Group: 1654
Docket No. 17595-00005

Mail Stop: Amendments
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Mail Stop: Amendments, Commissioner of Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 16, 2004.


Laurie Lopriore

RESPONSE

This is a Response to the Office Action dated November 16, 2004 in the subject application. The Applicant appreciates the Examiner's examination of the application and requests reconsideration and allowance based on the following remarks.

Please note that the Applicant's attorney's customer number is 28534 and the Applicant's attorney's correspondence address has changed to the following:

Jenifer Haeckl, Esq.
Mirick, O'Connell, DeMallie & Lougee, LLP
100 Front Street
Worcester, MA 01608

The Examiner is requiring a restriction under 35 U.S.C. § 121 to one of three categories of claims as categorized by the Examiner. In support of the restriction requirement, the Examiner states that the inventions are distinct, each from each other because they “are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects.” The Examiner further states that “in the instant case, the three different groups are directed to three different compositions comprising different ingredients.” In addition, the Examiner states that “different compositions comprising different ingredients do not necessarily have the same functional effect.” “Moreover, these compositions are capable of separate manufacture, use or sale, as claimed, and are patentable (novel and unobvious) over each other (though they may be unpatentable because of the prior art) subjects.”

In response, the Applicant respectfully traverses the Examiner’s conclusions regarding groups I-III. The three different groups are not directed at three different compositions comprising different ingredients. Rather all of the claimed compositions *comprise* all of the following components: cornmint oil, orange oil, pennyroyal oil; rosemary Spanish Oil, coriander oil, menthyl acetate, alpha pinene, beta pinene, camphor white oil, and calendula oil. Group III only requires these core components, while Group I comprises mineral oil and almond oil in addition to the core components, and Group II comprises mineral oil in addition to the core components.

To establish that combinations are distinct, two-way distinctness must be demonstrated. However, two-way distinctness is not evident because the Examiner has suggested a separate utility for each of the three groups and all the claimed combinations are directed at an


analgesic that comprises the core components. MPEP 806.05(c). The burden to suggest a separate utility for each of the groups rests on the Examiner. MPEP 806.05(c). In addition, there is no evidence provided by the Examiner that the formulations have different modes of operation, different functions, or different effects.

If a provisional election is required despite the traversal, the Applicant provisionally elects Group III that includes claims 9 and 10.

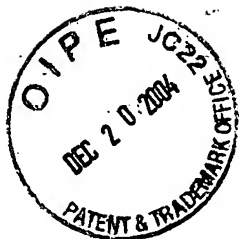
The Examiner's restriction requirement has been addressed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and favorable action is requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned in Worcester, Massachusetts at (508) 791-8500.

Respectfully submitted,



Jenifer E. Haeckl
Reg. No. 42,812



MIRICK O'CONNELL
ATTORNEYS AT LAW
MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP

December 16, 2004

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Dear Sir:

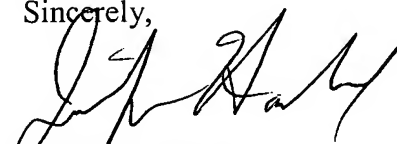
Enclosed is a Response to the Office Action mailed on November 16, 2004, in the subject application.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned in Worcester, Massachusetts (508) 791-8500.

If any payment during prosecution is found to be insufficient or if any overpayment is found, please charge any deficiency or credit any overpayment to my deposit account number 50-1582. A copy of this letter is enclosed for use by the Finance Branch in the event that it is necessary to make any charge or credit to my deposit account.

Kindly acknowledge receipt of the foregoing by returning the enclosed self-addressed postcard.

Sincerely,



Jennifer E. Haeckl

JEH/III
Enclosures

MIRICK O'CONNELL